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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Carlson et al.

Assignee: Maxtor Corporation

Title: DISK DRIVE WITH IMPROVED TECHNIQUES FOR
DETECTING HEAD FLYING HEIGHT (AS AMENDED)

Serial No.: 09/224,202 Filed: December 30, 1998

Examiner: Sniezek, A. Group Art Unit: 2753

Atty. Docket No.: 3123-233-1

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ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

PETITION FOR WITHDRAWAL OF RESTRICTION REQUIREMENT

Dear Sir:

This Petition is filed under 37 C.F.R. § 1.144 to request that the outstanding restriction requirement be withdrawn.

I. FACTS

The captioned-application was filed on December 30, 1998. The original application contained claims 1-46. A first Preliminary Amendment which accompanied the application canceled claims 21-46.

A second Preliminary Amendment was filed on May 25, 1999. The second Preliminary Amendment canceled claims 1-20 and added claims 47-106.

An Office Action was sent on October 22, 1999, in which a restriction requirement was issued and explained as follows:

This application contains claims directed to the following patentably distinct species of the claimed invention: There appears to be 5 distinct arrangements used to determine the acceptable flying height of a head as pointed out by Brief Description of the Drawings (figures 3-5, figure 6, figure 7, figure 8 and figure 9 along with corresponding disclosure).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Since the Examiner mentioned five distinct arrangements, Applicant presumed there was a five-way restriction requirement. However, the Examiner did not specify which claims belonged to which species. Furthermore, six independent claims (47, 57, 67, 77, 87 and 97) were pending.

Based on a review of the six independent claims, Applicant's best guess of the intended claim grouping was as follows:

| <u>Claims</u> | <u>Group</u> |
|---------------|--------------|
| 47-56 | I |
| 57-66 | II |
| 67-76 | III |
| 77-86 | IV |
| 87-106 | V |

Rather than second-guess the Examiner, the undersigned attorney called the Examiner and asked whether the grouping listed above was what the Examiner had intended. The Examiner indicated he did not wish to discuss the claim grouping over the telephone and asked that Applicant submit the claim grouping and election of species in a written response.

A Response was filed on November 2, 1999. In the Response, Applicant indicated that the following claim grouping was presumed:

| <u>Claims</u> | <u>Group</u> |
|---------------|--------------|
| 47-56 | I |
| 57-66 | II |
| 67-76 | III |
| 77-86 | IV |
| 87-106 | V |

Applicant also elected claims 87-106 (Group V) and requested that the Examiner confirm the claim grouping in the next written communication.

An Office Action was sent on January 18, 2000, which stated as follows:

The reply filed on 11/10/1999 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Applicant has not elected one of the species referred to in the specification and as outlined by examiner in the previous office action. Examiner acknowledges that applicant has stated that he wishes to prosecute claims 87-106 in this application, however applicant has not stated which figure or figures, i.e., which specie is elected. See 37 CFR 1.111.

A Petition for Withdrawal of Requirement to State Figures and for Clarification of Claim Grouping was filed on February 4, 2000. The Petition stated as follows:

This Petition is filed for two reasons. First, the Examiner has yet to specify the claim grouping in the restriction requirement. Second, the Examiner is requiring that Applicant specify figures as an election of species. Applicant does not understand how to specify figures for an unknown claim grouping. Further, even if the Examiner specified the claim grouping (or confirmed Applicant's presumed claim grouping), Applicant believes it is improper for the Examiner to require that Applicant match up various figures with claim groups in response to a restriction requirement.

The Examiner appears to be attempting to shift the responsibility for defining the restriction requirement from himself

to the Applicant. Applicant is not aware of any authority that supports this role reversal.

In sum, Applicant has attempted to clarify the claim grouping in the restriction requirement and has submitted a provisional election. In this Petition, Applicant respectfully requests that the Examiner (1) withdraw the requirement that Applicant specify figures in response to the restriction requirement, and (2) clarify the claim grouping in the restriction requirement.

A third Preliminary Amendment was filed on April 7, 2000. The third Preliminary Amendment added claims 107-126.

An Office Action was sent on April 13, 2000, which vacated the previous restriction requirement and entered a nine-way restriction requirement. Again, no claims were specified, and the nine species were defined by groups of figures as follows:

| <u>Specie</u> | <u>Figures</u> |
|---------------|----------------|
| 1 | 8,4,3 |
| 2 | 8,4,6 |
| 3 | 8,4,7 |
| 4 | 8,9,3 |
| 5 | 8,9,6 |
| 6 | 8,9,7 |
| 7 | 5,4,3 |
| 8 | 5,4,6 |
| 9 | 5,4,7 |

In sustaining the restriction requirement, the Examiner stated as follows:

The disclosure presents two flying height determination arrangements as depicted in figures 5 and 8. The figure 5 arrangement is based on comparisons made between signals and the arrangement of figure 8 is based on the number of peaks detected. The arrangement of figure 5 can be used with each of the servo patterns as depicted in figures 3, 6 and 7; with the read signal taking the form as depicted in figure 4. The arrangement in figure 8 can be used with each of the servo patterns as depicted in figures 3, 6 and 7; with the read signal taking the form as depicted in either figure 4 or 9. All together this provides for 9 separate specie in which flying height is determined.

It is noted that the decreasing signal as depicted in figure 9 is not disclosed as being used with the arrangement in figure 5. If it would have then there would be an additional three species.

A Response was filed on June 2, 2000, in which claims to species 1 (Figures 8, 4 and 3) were provisionally elected:

Applicant provisionally elects species 1 (claims 47-50, 53-79, 81-106, 108-113, 115, 118-123, 125) with traverse.

Applicant also pointed out that in accordance with the M.P.E.P., the Examiner must show by appropriate explanation one of the following: (A) separate classification thereof; (B) a separate status in the art when they are classifiable together; or (C) a different field of search, and that the Examiner had not even attempted to establish these mandatory elements.

An Office Action was sent on July 28, 2000, which withdrew claims 51, 52, 59, 60, 67-86, 89, 90, 99, 100, 107, 114, 116, 117 and 124 from consideration. As a result, the Examiner withdrew claims 59, 60, 67-79, 81-86, 89, 90, 99 and 100 even though Applicant provisionally elected these claims.

The Examiner addressed the above-mentioned mandatory elements set forth in the M.P.E.P. as follows:

The traversal is on the ground(s) that there must be a serious burden in examination for the restriction to be proper. This is not found persuasive because looking for numerous different species is a serious burden on the examiner.

The Examiner explained the basis for restriction as follows:

Claims 59, 60, 67-79, 81-86, 89, 90, 99 and 100 are directed to the use of a random data pattern or a linearly increasing data pattern which do not correspond to the two frequency data pattern of elected species figure 4. Claims 59, 60, 67-79, 81-86, 89, 90, 99 and 100 are therefore also non-elected and will not be examined in this application.

→ A Response filed concurrently herewith has amended claims 47, 57, 67 and 77 to depend from claim 87. Therefore, claims 87 and 97 are currently the only independent claims in the case.

II. ARGUMENT

The independent claims (87 and 97) recite a disk drive comprising a disk having a plurality of concentric tracks for storing data, and a head for reading data from and writing data to the disk. They also recite a first track having a first data pattern with a first frequency and a second data pattern with a second frequency that is higher than the first frequency, and that the first and second data patterns are located in separate non-overlapping circumferential portions of the first track. They also recite a detection circuit that determines whether the head is within an acceptable flying height range in response to the first and second data patterns.

There must be a serious burden on the examiner if the restriction is required (M.P.E.P. § 803). Where the related inventions as claimed are shown to be distinct, the Examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (A) separate classification thereof; (B) a separate status in the art when they are classifiable together; or (C) a different field of search (M.P.E.P. § 808.02).

The Examiner has not even attempted to explain how examining species 1-9 would involve separate classification, separate status in the art, or a different field of search (M.P.E.P. § 808.02). Instead, the Examiner merely asserts that looking for different species automatically establishes a serious burden. Applicant believes this ignores the mandatory elements set forth in the M.P.E.P. and therefore is improper.

The Examiner has not explained the basis for withdrawing claims 51, 52, 107, 114, 116, 117 and 124. These claims do not recite a random data pattern or a linearly increasing frequency data pattern. Therefore, Applicant believes this is improper.

applicant indicated (paper #12) that they don't belong to elected species

The Examiner has withdrawn numerous claims that were provisionally elected. Applicant believes this is improper.

For these reasons, Applicant respectfully requests that the restriction requirement be withdrawn.

Please charge any fee due under this Petition to Deposit Account No. 13-0016/233-1.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on August 4, 2000.

D. Sigmond

David M. Sigmond
Attorney for Applicant

8,4,00

Date of Signature

Respectfully submitted,

D. Sigmond

David M. Sigmond
Attorney for Applicant
Reg. No. 34,013
(303) 702-4132
(303) 678-3111 (fax)



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